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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/380,731	09/13/99	RETENMAIER	017409/8175

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KIM S EXAMINER

ART UNIT PAPER NUMBER

08/01/00

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/380,731

Applicant(s)

Rettenmaier

Examiner

John KimGroup Art Unit
1723☒ Responsive to communication(s) filed on Jul 12, 2000☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-35 is/are pending in the application.Of the above, claim(s) 15-35 is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-14 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant's election of Group I (claims 1-14) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 15-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse as described in above paragraph.
3. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because Pages 3 and 4-5 repeat itself and page 3 and page 4 does not connect grammatically. Units used in the specification is unclear because the unit is not spelled out. For example, 1.1 billion hl beer on page 2 and DM 600.00 per t of kieselguhr on pages 3-4 do not spell out what "hl" and "t" are. Pages 4a, 5a, 5b, 6a, 7a, 8a, 9a and 10a have pages with empty spaces. Pages 11-14 are missing. Pages need to be renumbered.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention thereof by the applicant for patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,866,242 (hereinafter referred to as Tan et al.). Tan et al teach wood pulp fibers subjected to a dilute alkali metal salt solution at a temperature of from 15 to about 60 degree Celsius and including organic particulates and filter active fractions (see col. 3, line 66 - col. 4, line 7; col. 4, line 58 - col. 5, line 12).

7. Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,288,462 (hereinafter referred to as Hou et al '462). Hou et al '462 teaches filter media sheet comprising cellulose fibers of different pulps or differently beaten pulps and perlite and silica (i.e. kieselguhr) (see col. 3, line 54 - col. 4,

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line 26; col. 5, line 6 - col. 6, line 36; col. 10, line 64 - col. 11, line 12). Hou et al '462 teaches that filter sheet made of cellulose fibers are free of extractables and are free of discoloration (see col. 3, lines 59-69). "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

8. Claims 1-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,488,969 (hereinafter referred to as Hou). Hou teaches filter media sheet comprising cellulose fibers of different pulps or differently beaten pulps in fiber diameter of 15 to 25 microns and fiber length of about 0.85 mm and perlite and silica (i.e. kieselguhr) (see col. 3, lines 13-27; col. 4, line 57 - col. 5, line 55; col. 9, lines 57-64). "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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9. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,599,240 (hereinafter referred to as Thompson). Thompson teaches cellulose fibers produced from wood chips cooked and digested at an elevated temperature with a mixture of sodium hydroxide and sodium sulfite solution (see col. 2, lines 7-17). "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. No. 5,769,934 and 4,367,150 and 4,366,068 and 4,361,486 and 5,916,670 teach wood fibers in a filter or method of making cellulose fibers.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (703) 308-2350. The examiner can normally be reached on weekdays from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for official response after final action is (703) 305-3599, and the fax phone number for all other official faxes is (703) 305-7718.

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When sending a draft amendment by fax, please mark the paper as "DRAFT"; otherwise, mark the paper "OFFICIAL". This will expedite the processing of the paper.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



John Kim
Primary Examiner
Art Unit 1723

J. Kim
July 28, 2000